

Application No. 10/613,678
Amendment dated April 10, 2006
Reply to Office action of January 10, 2006

REMARKS

Claims 1-35 are pending in the application after this amendment. The amendment and/or addition of claims is not to be considered in any way an indication of applicant's position on the merits of the amended, added, and/or original claims. Claims 17 and 23-25 have been indicated as having allowable subject matter, the indication of which is appreciated. In the following sections of the Amendment the rejections set forth by the Examiner in the January 10, 2006, Office action are addressed. These rejections are respectfully traversed, and detailed arguments are set forth below.

Applicant would like to express appreciation for the Examiner's time he spent discussing this application and the cited references (U.S. Patent No. 5,785,705 to Baker (the "Baker reference") and U.S. Patent No. 6,482,204 to Lax et al. (the "Lax reference")) and claim 1 as an exemplary claim. We also briefly discussed claim 4 and the structural features associated therewith.

Incorporated herein (without repetition) are the specific recitation of the facts and the specific arguments found in previous papers.

As a first preliminary matter, applicant respectfully requests that the references submitted on the January 9, 2004 Information Disclosure Statement (IDS) with Foreign Patent Document WO01/26570 be considered and acknowledged. Applicant has verified on the PAIR Image File Wrapper that the IDS was received by the PTO on January 12, 2004.

The Examiner rejected claim 4 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. More specifically, the Examiner rejected claim 4 stating that the exact meaning of the term "heat generation layer" is unclear. Applicant has amended claim 4 by replacing the term "heat generation layer" with "energy application layer containing heating elements." Applicant has made this amendment for the purpose of furthering prosecution, but reserves the right to file continuation applications.

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The Examiner rejected claims 1-8 under 35 USC §102(b) as being anticipated by the Baker reference. The Examiner also rejected claims 1-16 and 18-21 under 35 USC §102(b) as being anticipated by the Lax reference. The Examiner has rejected claim 22 under 35 USC §103 as being unpatentable over the Lax reference in combination with U.S. Patent No. 5,049,147 to Danon (the "Danon reference") and U.S. Patent No. 6,736,833 to Coleman (the "Coleman reference").

Claims 1-8, 11, and 20-21 all specific include the element of "ribbon-like." The Examiner directs applicant's attention to FIG. 2 of the Baker reference and FIGS. 2, 3, 7, 9, and 10 of the Lax reference as showing this structure. Incorporated herein (without repetition) are the specific recitation of the facts and the specific arguments found in previous papers that show that the term "ribbon-like" is sufficient to overcome this rejection. Applicant has also added new claims 26-29. These new claims specify that the energy application head is "elongated and relatively flat" and that the energy application head has a length that is "at least three times said width" and a height that is "less than half said width." These limitations are not new matter as they are shown in the original FIGS. 29-32 as well as in the exemplary measurements set forth in the original specification at page 16, lines 12-16:

"The dimensions shown are meant to be exemplary and are primarily for purposes of illustration. In one preferred embodiment, the thickness of a contracted ribbon head is approximately 1-3 mm and the thickness of an expanded ribbon head is approximately 5-10 mm. Depending on the application (e.g. the size of the patient), the ribbon head would range from 30 mm to 80 mm in length."

As cited references do not teach or suggest at least one of the claimed features, applicant respectfully submits claims 1-8, 11, 20-21, and 26-29 (and any claims that depend therefrom) should be allowable.

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Applicant has amended claims 3 and 5-8 to specify that the specified layer(s) are internal to the energy application head. This is shown in FIGS. 29, 30, and 32. This is also specified in the original specification at page 15, lines 8-11:

“In one preferred embodiment, the ribbon head 800 is layered in that it includes a bottom layer 802, an optional middle layer 804, and a top layer 806. Preferably, these layers are internal and the exterior surface is substantially free of structure that could snag or tear tissue.”

New claims 30-32 are directed to embodiments that include an internal top layer and an internal bottom layer. As cited references do not teach or suggest at least one of the claimed features, applicant respectfully submits claims 3, 5-8, and 30-32 should be allowable.

Claim 2, as amended, and new claims 33-35 specify that the energy application head has an expandable and contractible layer that is opposite the treatment area surface of the energy application region. This relationship is shown in the original figures. As cited references do not teach or suggest at least one of the claimed features, applicant respectfully submits that claims 2 and 33-35 should be allowable.

In view of the above, it is submitted that the currently pending claims are patentable. Accordingly, the Examiner is requested to reexamine the application, to allow the claims, and to pass the application on promptly to issue.

Please charge Deposit Account No. 50-2115 for any additional fees that may be required.

Respectfully submitted,



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